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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/524,693 | 03/14/2000 | Junichiro Yamada | 044499/0108 | 8885 |
| 22428 | 7590 | 08/25/2004 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | CHAWAN, SHEELA C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2625 | |
| DATE MAILED: 08/25/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/524,693 | YAMADA ET AL. | |

| | | |
|-----------------|-----------------|--|
| Examiner | Art Unit | |
| Sheela C Chawan | 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,4,6-8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3,4,6-8 and 11-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on July 2, 2004 has been fully considered and is persuasive. In response to applicant's persuasive arguments, the finality of last office action is withdrawn.

Claim 14 is new claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(a) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 6 - 8, 11-14 are rejected under 35 U.S.C.103(a) as being unpatentable over Piosenka et al. (Listed in the IDS paper No. 4, (US.4, 993,068), in view of Scott et al. (US. 6,484,260 B1).

As per claim 1, Piosenka teaches a personal identification device for executing personal identification by employing living body characteristics of a user (living body characteristics of a user is considered to be called as Bio data or biometric data fig 1, such as facial photograph or retinal pattern or fingerprint or voice patterns, column 3, lines 45- 59, column 4, lines 45- 68, column 5, lines 1-27):

identification condition data specifying, at least one living body characteristic stored in a portable storage media carried by the user for the personal identification (identification condition data that specifies living body characteristic herein after is referred to bio data, abstract, column 2, lines 61- 66, column 8, lines 33-68);

a living body characteristic detector (fig 1, item 10) for detecting from the user the living body characteristic data corresponding to the identification condition data read by said identification condition data reader (column 2, lines 61- 68, column 3, lines 1-8);

a peripheral controller to control the living body characteristic detector (at least in figure 1, interface elements 21-23 provide a function of a peripheral controller by controlling the elements 13-15, the living body characteristic detectors such as retinal scanner, finger print reader and voice print processor;

an identifier for performing personal identification (column 3, lines 1-8, fig 1, 11-15) by comparing the living body characteristic data detected by the living body

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characteristic detector with living body characteristic data of users previously obtained (column 3, lines 44- 48, column 4, lines 45- 68, column 5, lines 1-19).

Piosenka is silent about specific details of portable storage media stores therein an identification algorithm for personal identification by transferring the detected living body characteristic to the portable storage media.

Scott discloses a portable personal identification device for providing secure access to a host facility includes a biometric sensor capable of sensing a biometric trait of a user that is unique to the user and providing a biometric signal. The system comprises of:

wherein said portable storage media stores therein an identification algorithm for personal identification employing said detected living body characteristic together with said living body characteristic data (the personal identification that is associated with the user i.e., the ID code, the personal encryption key, and the fingerprint template, is stored in a smart card, column 5, lines 16- 25), and said identifier performs said personal identification by transferring said living body characteristic data detected from the user by said living body characteristic detector to said portable storage media (column 2, lines 44- 67, column 3, lines 1-3, column 5, lines 16- 27, column 6, line 54 through column 7, line 8, column 8, lines 60 –65, column 9, lines 8-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Piosenka to include a portable storage media stores therein an identification algorithm for personal identification by transferring to a portable storage media. It would have been obvious to one of ordinary skill in the art at the time of the

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invention to modify Piosenka by the teaching of Scott in order to save the size of the memory and improve the speed of processing by decreasing the time it takes to transfer finger models to and from the internal memory (as suggested by Scott at column 9, line 13 -15).

As per claim 4, see the rejection of claim 1.

As per claim 8, see the rejection of claim 1.

As per claim 14, see the rejection of claim 1.

As per claims 3 and 6, Piosenka teaches a personal identification device in which said portable storage media stores therein said living body characteristic data, said identification condition reader reads said living body characteristic data from said portable storage media together with said identification condition data, and said identifier performs said personal identification by comparing said living body characteristics detected from the user by said living body characteristic detector with said living body characteristic data read from said portable storage media (column 4, lines 61- 68, column 5, lines 1-27) .

As per claim 7, Piosenka teaches a personal identification apparatus according to claim 4, in which said central device stores and manages said living body characteristic data for each user, revises said living body characteristic data for each user stored and managed by communication with each of said personal identification terminals, and controls identification results of users from said personal identification terminals (column 3, lines 34- 65, column 4, lines 1-16).

As to claims 11,12 and 13 Scott discloses a personal identification device wherein said portable storage media is an IC card (fig 4A and fig 4B, column 10, lines 6-13).

REMARKS

3. In the remark, applicants have argued in substance that
 1. Piosenka fails to teach or suggest a “ portable storage media stores therein an identification algorithm for personal identification “.
 2. Scott also fails to teach or suggest transferring the detected living body characteristic data to a storage media.

In the reply, the examiner states the following.

As to point 1, with respect to the art rejection, the examiner has carefully considered applicant's argument, but firmly believes the cited reference to reasonably and properly meet the claimed limitation. The examiner does not agree with the remarks that Piosenka cannot be said to teach or suggest portable media for storing identification information. At the begin of the body of the claim recites only “ portable storage media” which stores credentials identification information which is taught by Piosenka, see abstract, column 3, lines 45- 59, column 4, lines 45- 68, column 5, lines 1-27). The first element of the body of claim does not recite “ algorithm nor transferring “. The very last paragraph of the claim does recite this limitation. The examiner has brought in secondary teaching (Scott) for this limitation as discuss below. However,

applicant is reminded that the claim language is given its broadest reasonable interpretation.

As to point 2, with respect to the art rejection, the examiner has carefully considered applicant's argument, but firmly believes the cited reference to reasonably and properly meet the claimed limitation. The examiner does not agree with the remarks that Scott cannot be said to suggest or teach " performing personal identification by transferring the detected living body characteristic to the portable storage media ". Scott is relied upon to provide this feature as stated in very last element of the body of the claim. The claim recites portable storage media stores identification algorithm for personal identification and than by transferring to a portable storage media (see column 6, line 54 through column 7, line 8, column 8, lines 60- 65 and also see column 9, lines 8-15). Therefore, the examiner has been fully considered but they are persuasive with respect to the art rejection to be proper.

Contact Information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela C Chawan whose telephone number is 703-305- 4876. The examiner can normally be reached on Monday - Thursday 6 - 7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 703-308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SCC
Sheela Chawan
Patent Examiner
Group Art Unit 2625
August 19, 2004

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